

Attorney Docket No. P11303

REMARKS/ARGUMENTS

Claims 1-40 are pending and have not been amended. The pending claims are listed above for the Examiner's convenience.

Claim Rejections – 35 U.S.C. § 103(a)**Claims 1-25, 28, 30, 33-39 and 40**

The Examiner rejected claims 1-25, 28, 30 and 33-40 under 35 U.S.C. § 103 (a) as being unpatentable over Byrne (US 5,737,703) and further in view of Lintulampi (US 6,377,804). The Applicant respectfully traverses this rejection for the following reasons:

Claims 1, 15, and 40

The Applicant notes that each of the claims 1, 15 and 40 contain an element or step for "selecting, in the case of that the handover is necessary, which communication or communications are handed over." The Applicant respectfully submits that neither Byrne nor Lantulampi describe selecting, in the case that the handover is necessary, which communication or communications are handed over. In the case of the recited references, the discussion is only made with respect to a single communication which is handed over between systems.

In paragraph 1 of the Office Action, the Examiner stated "the Applicant's arguments with respect to claims 1, 15, and 39 have been considered, but are moot in previous rejection." In paragraph 2, the Examiner stated:

The examiner disagrees because the modified Byrne discloses "the cellular cordless telephone continuously monitors for radio system availability, and automatically selects and reselects radio systems, there exists the possibility of a new or different radio system" (see Byrne, col. 6, lines 26-35), and the examiner interprets "radio system" corresponds to "communication." (emphasis added).

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The Applicant respectfully disagrees with the Examiner's interpretation of the term "communication." Therefore, the Applicant believes the Examiner has misinterpreted the meaning of the claims.

As is well known in the art, a "radio system" is simply not the same as a "communication." Additionally, the term "communication" is partially defined in the Applicant's specification on page 2, lines 20-23, as:

Future communication systems will allow mobile user equipments to perform a greater number of communications simultaneously. Examples of the communication include telephone calls, faxes, downloading of data or uploading of data (file transfer).

Thus, there is no doubt that the term "communication" is not the same element as the term "radio system." The claims, therefore, do not recite a means for monitoring radio system availability, and a means for selecting radio systems as discussed in Byrne. In contrast, each of the independent claims 1, 15, and 40 contain an element or step for "selecting, in the case of that the handover is necessary, which communication or communications are handed over." As the Examiner has implicitly admitted, this element is not discussed nor disclosed in Byrne. The Examiner cannot simply redefine a term and force his own definition upon the Applicant to support a rejection - especially when the term has been previously defined in the Applicant's specification.

In order to establish a *prima facie* case of obviousness, the cited references must collectively disclose all of the elements of the rejected claims. As shown above, Byrne does not disclose an element for "selecting, in the case of that the handover is necessary, which communication or communications are handed over." Additionally, Lintulampi, does not make up for the shortcomings of Byrne because it also does not show the missing elements of base claims 1, 15 and 40. Thus, allowance of claims 1, 15 and 40 is respectfully requested.

Claims 2-14, and 16-38, recite further limitations in combination with the novel elements of base claims 1 and 15. Therefore, the allowance of dependent claims 2-14, and 16-38 is also respectfully requested.

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Claim 39

With respect to claim 39, the Applicant previously argued that Byrne does not describe maintaining a communication on hold during and after an intersystem handover.

In response, the Examiner stated:

With argument respect to claim 39, Byrne discloses in the abstract "Communication with respective radio telephone system may be simultaneously continued during handover until the handover is complete", which reads on "a call being place on hold or the handover of a call placed on hold" with broadest reasonable interpretation."

Paragraph 2, Office Action dated June 5, 2003.

The Applicant respectfully disagrees with the Examiner's interpretation of the cited passage. A more complete excerpt from the Abstract of Byrne is reproduced below:

Communication with respective radio telephone systems may be simultaneously continued during handover until the handover is complete or the communication with one radio telephone system ceases before communication with the other radio telephone system commences. Delays between signals of different radio telephone systems which would cause audible interference are inhibited by FIR filtering and/or dynamic time-warping.

The Applicant again notes that the cited passage says absolutely nothing about placing a communication on hold. The passage merely states that transmission of communication or call data will continue during a handover. In fact, the "continuing communication" as described above inhibits delays that could cause audible interference. Thus, in Byrne, call data (e.g., voice data) continues to be sent throughout the handover procedure. This is in sharp contrast to the claimed elements of "holding at least one of the communications" and "maintaining said at least one of the communications on hold during and after the intersystem handover" - where the sending of communication or call data is stopped.

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There is little doubt as to the meaning of the claimed elements. As indicated in the Applicant's specification on page 45, lines 9 through 16:

The core network CN sends a hold order HO to the mobile user equipment MUE. The hold execution element HE puts the requested call on hold and sends a message for hold acceptance HOA to the core network.

Thus, it is clear that the claimed elements of "holding at least one of the communications" and "maintaining said at least one of the communications on hold during and after the intersystem handover" are not the continued communications as described in Byrne. The claimed elements are simply not discussed in Byrne.

As discussed previously, in order to establish a *prima facie* case of obviousness, the cited references must collectively disclose all of the elements of the rejected claims. As shown above, Byrne does not disclose an element for "holding at least one of the communications" and "maintaining said at least one of the communications on hold during and after the intersystem handover." Additionally, Lintulampi, does not make up for the shortcomings of Byrne because it also does not show the missing elements of claim 39. Thus, allowance of claim 39 is respectfully requested.

Claim 29

The Examiner rejected claim 29 under 35 U.S.C. § 103 (a) as being unpatentable over Byrne (US 5,737,703) in view of Lintulampi (US 6,377,804) and in further view of Naghshineh, M. et al. (End-to-end QoSprovisioning in Multimedia Wireless Mobile Networks Using an Adaptive Framework, November 1997, IEEE Communications Magazine, pp. 72-81).

As discussed above, in order to establish a *prima facie* case of obviousness, the cited references must collectively disclose all of the elements of the rejected claims. Claim 29 ultimately depends from base claim 15. As shown above, Byrne does not disclose all of the elements of claim 15. Lintuampi and Naghshineh do not make up for the shortcomings of Byrne because they likewise do not show the missing elements of the base claim 15. Therefore, the allowance of dependent claim 29 is respectfully requested.

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Claims 26-27, 31-32

The Examiner rejected claims 26-27, 31-32 under 35 U.S.C. § 103 (a) as being unpatentable over Byrne (US 5,737,703) in view of Lintulampi (US 6,377,804) and in further view of Acampora et al. (US 5,497,504).

In order to establish a *prima facie* case of obviousness, the cited references must collectively disclose all of the elements of the rejected claims. Claims 26-27 and 31-32 ultimately depend from base claim 15. As shown above, Byrne does not disclose all of the elements of claim 15. Lintuampi and Acampora do not make up for the shortcomings of Byrne because they likewise do not show the missing elements of the base claim 15. Therefore, the withdraw of the rejection under § 103 and allowance of dependent claims 26-27 and 31-32 are respectfully requested.

CONCLUSION

In view of the foregoing remarks, the Applicant believes all of the claims currently pending in the Application to be in a condition for allowance. The Applicant, therefore, respectfully requests that the Examiner withdraw all rejections and issue a Notice of Allowance for all pending claims.

The Applicant requests a telephonic interview with the Examiner if the Examiner has any questions or requires any additional information that would further or expedite the prosecution of the Application.

Respectfully submitted,



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